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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,337	11/07/2005	Jan Schroers	L2:00555	1291
71897	7590	10/08/2008		
KAUTH, POMEROY, PECK & BAILEY, LLP				
P.O. BOX 19152				
IRVINE, CA 92623				
EXAMINER				
WYSZOMIERSKI, GEORGE P				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
10/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,337

Applicant(s)

SCHROERS ET AL.

Examiner

George P. Wyszomierski

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8, 12-15, 17, 18, 20, 24-32, 34, 36, 39, 40, 42, 44, 46 and 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 6, 8, 12-15, 17, 18, 20 and 24 is/are allowed.
- 6) ☒ Claim(s) 5, 25, 26, 28, 31, 34, 36, 39, 40, 42, 44, 46 and 47 is/are rejected.
- 7) ☒ Claim(s) 27, 29, 30 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/25/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The Amendment filed June 25, 2008 has been entered. Claims 1-3, 5, 6, 8, 12-15, 17, 18, 20, 24-32, 34, 36, 39, 40, 42, 44, 46 and 47 are pending in this application.

Claim Interpretation

2. It is noted that in instant claims 25-27, each of x, y and z can be zero. In claims 28-30, each of x and z can be zero.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The "wherein" clause in this claim appears to be superfluous. Three possible scenarios are recited for the ratio of Pd to Pt, based on the total content of Pd and Pt. Given that independent claim 1 requires the amount of platinum to be from about 39 to about 50 atomic %, and given further the amounts of other elements required in the alloy of claim 1, it does not appear possible for the ratio of Pd to Pt to be anywhere outside the ranges as defined in claim 5.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 25, 26, 28, 31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2002-275605.

At least alloy no. 45 on page 8 of the JP '605 reference appears to be fully in accord with the compositions recited in the instant claims, and has a hardness within the range of instant claim 36.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 34, 39, 40, 42, 44, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-275605.

The JP '605 reference discloses alloy compositions that fully meet the compositional limitations required by the instant claims, as set forth in the rejection under 35 USC 102 *supra*. JP '605 does not disclose the properties as defined in the instant claims. However, because the actual compositions of the prior art and the instant claims may be identical, it is a reasonable assumption that the properties thereof would likewise be the same or nearly so; see *In re Best* (195 USPQ 430, CCPA 1977) or *In re Spada* (15 USPQ2d 1655, Fed.Cir. 1990). Thus, a *prima facie* case of obviousness is established between the disclosure of JP 2002-275605 and the presently claimed invention.

8. In a response filed June 25, 2008, Applicant has amended the claims such that none of the presently claimed compositions are disclosed or rendered obvious over the previously cited Shimizu et al. reference. However, a number of the instant claims remain rejected in view of the JP '605 reference, as indicated above. Because this

rejection was not previously applied against claims 25 and 26, this action is non-final.

The prior art cited in the IDS filed June 25, 2008 has been fully considered.

9. Claims 1-3, 6, 8, 12-15, 17, 18, 20 and 24 are allowable over the prior art of record, and claims 27, 29, 30 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/George Wyszomierski/
Primary Examiner
Art Unit 1793

GPW
October 6, 2008